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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,603	07/23/2004	Horst Mellis	M15P01US	4602

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EXAMINER

EVANISKO, LESLIE J

ART UNIT PAPER NUMBER

2854

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary	Application No. 10/710,603	Applicant(s) MELLIS, HORST	
	Examiner Leslie J. Evanisko	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10-20-2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: dashed line 40 described in paragraphs [0048]-[0049].

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the provision of two stencils with the article being placed between the two stencils as recited in claims 6 and 18 must be shown or the feature(s) canceled from the claim(s). Additionally, the base element of the adapter being a bar, angle piece, or U-shaped frame as recited in claim 14 must be shown or the feature(s) canceled from the claim. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required

corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 12-15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It appears that applicant was intending to recite that an adapter for use with a stencil holder in combination with a stencil. However, as currently recited, claim 12 is a claim in dependent form but is so worded that it does not include every limitation of the claim on which it depends. In particular, claim 12 is drawn to an adapter per se and does not require all of the structure of the device of claim 1. Appropriate correction and/or clarification is required.

In an effort to advance prosecution, the Examiner has assumed that claims 12-15 are drawn to an adapter structure for use with a stencil and stencil holder.

5. Claims 16-18 are objected to because of the following informalities: With respect to claim 16, line 11, it appears the term --the-- was inadvertently omitted from before "first" (second occurrence). Additionally, in claim 17, line

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2, it appears that the term --of-- was inadvertently omitted and should be inserted before the term "placing". Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2, 5, 7-8, and 12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Vasilantone (US 3,244,093). Vasilantone teaches a device comprising at least one stencil 40 configured to apply a pattern onto a flat surface of an article S, and a stencil holder 30, 32, 34, 36, 37, wherein the stencil holder comprises first means 37' for securing the stencil in a predetermined position relative to the stencil holder, and the stencil holder comprises second means 37, 41, 42 for positively securing the surface of the article onto which the pattern is to be applied relative to the stencil holder, the second means comprising a first recess (opening 42) provided in the stencil holder to provide a positive securing action for the surface of the article.

With respect to claims 2, 8, and 17, note Vasilantone teaches an adapter 44 configured to be inserted in the recess 42 to adjust the size of the recess so that the recess and adapter together provide the positive securing action. See column 2, lines 13-18 in particular.

With respect to claim 5, note the first means of Vasilantone comprises a second recess (i.e., the recess created by walls 30, 32, 34, 36), the second recess being configured such that when the stencil is inserted in the recess, the stencil and stencil holder form a substantially flush surface, as shown in Figures 2-3 in particular.

With respect to claim 12, note Vasilantone teaches an adapter 41, 44, for use with a stenciling device comprising a base element configured to adjust means for securing the surface of the article relative to a stencil holder to a certain size of the article.

With respect to claim 13, note the base element of Vasilantone is capable of adjusting the means for securing to a standard paper size and therefore meets the language as recited.

With respect to claims 14-15, note the base element of Vasilantone can be considered to be a bar, frame, or plate with a recess as broadly recited.

With respect to claim 16, note Vasilantone teaches a method for applying a pattern onto a surface as recited.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3-4, 6-7, 9-11, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson et al. (US 2003/0118689 A1) in view of Volk (US 5,533,900). Carlson et al. teach a device 10 comprising at least one stencil 12, 14 configured to apply a pattern 22, 24 onto a flat surface of an article 26, and a stencil holder 18, wherein the stencil holder comprises first means 56, 20 for securing the stencil in a predetermined position relative to the stencil holder. Furthermore, it is noted that Carlson et al. teach the stencil holder comprises second means including a first recess 30. Although it is not clear whether this recess in Carlson et al. specifically functions to positively secure the surface of the article onto which the pattern is being applied relative to the stencil holder, it is noted that Carlson et al. specifically teach in paragraph [0023] that the embossing system 10 is sized depending upon the particular requirements of the user and further teaches the system can be sized to correspond to standard 8 1/2 x 11" paper or could be sized to fit standard greeting cards or other paper items. Furthermore, one of ordinary skill in the art would recognize that the device of Carlson et al. would not

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properly operate to emboss the article if the article being printed was not properly secured or fixed in the device. Therefore, it appears that Carlson et al. implies or at least renders obvious sizing the recess to provide positive securement of the article being printed in the device. Regardless, it is well known in the art to provide a stencil holder with an opening sized to positively secure the object being printed, as exemplified by the stencil holder including a recess (formed by retaining wall 20) of Volk as described in column 5, lines 51-57 in particular. In view of the above teachings, it would have been obvious to one of ordinary skill in the art to provide the recess of Carlson et al. be sized to provide positive securing action for the surface of the article to be printed to prevent the article being printed from moving in relation to the stencil holder and thereby causing blurry or improper printing.

With respect to claims 3 and 9, note the first means of Carlson et al. includes elements 20 projecting upwardly away from the stencil holder.

With respect to claims 4 and 10, note the stencils 12, 14 of Carlson et al. include perforations 32, 34 configured to engage with short securing pins 20 on the stencil holder 18.

With respect to claim 6, note Carlson et al. teach two embossing stencils 12, 14, a first one 14 of the embossing stencils placed underneath the surface of the article 26 and a second one 12 of the embossing stencils placed on top of the surface of the article and secured by the first means 20, 56. See Figures 1A and 1B in particular.

With respect to claim 11, note the base member of Carlson et al. has receiving openings 56 and the elements projecting upwardly are insertable into the receiving openings in different arrangements.

With respect to claims 16 and 18, note paragraph [0028] of Carlson et al. in particular teach a method for applying a pattern to a surface as recited.

Conclusion


10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Proffer (US 5,127,321), Klaja (US 3,861,066), Slayton (US 5,100,324), Goss (US 6,776,091), Erdmann (US 6,494,134), and Summer (US 2,444,860) each teach a stencil device having obvious similarities to the claimed subject matter.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Leslie J. Evanisko
Primary Examiner
Art Unit 2854

lje
February 18, 2005